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Alex Mashinsky

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EXAMINER

KUDDUS, DANIEL A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,264	Applicant(s) MASHINSKY, ALEX	
	Examiner DANIEL KUDDUS	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

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Response to Amendment

1. This Office action has been issued in response to amendment filed November 24, 2008. In response to last office action, claim 9 has been amended. Accordingly, claims 9-23 remain pending in this application. Applicant's arguments are carefully and respectfully considered and some are persuasive, while others are not. Accordingly rejections have been removed where arguments were persuasive, but rejections have been maintained where arguments were not persuasive. Also, a new rejections based on the newly added claims have been set forth. Accordingly, claims 1-20 are rejected and this action has been made **FINAL**, as necessitated by amendment.

Response to Arguments

2. With respect to applicant's arguments that "*claim 22 stand rejected under 35 USC 112, second paragraph..... FIG. 1 is an exemplary schematic block diagram illustrating the interaction between different elements of an information exchange in accordance with the invention; related parties or other systems that have expressed an interest in being notified of the type of published information as it becomes available. RSS is an XML format for sharing headlines and other web content". Therefore, a definition of the specific type of information is included in the specification such that the skilled person is reasonably apprised of the scope of the claimed invention. In view of the foregoing, reconsideration and withdrawal of the rejections are requested*". Examiner respectfully disagrees. Applicant's original specification describe related parties or other systems that have expressed an interest in being notified of the type of

published information as it becomes available...etc. However, claim recites limitation is 'specific format', which can be any special, particular or precise format. Therefore, the phrase specific format is indefinite and vague. As such the rejection is hereby sustained.

With respect to applicant's arguments that "*Ueda fails to teach or suggest at least the step of entering and storing search queries as static queries in a system database, which are used for retrieving information pertaining to the static queries from the internet, said static queries being input from users or subscribers to the information exchange, as recited in now amended independent claim 9*". The Examiner respectfully disagrees with applicant's arguments. Ueda in fact teaches the amended claim recites limitations. Ueda teaches (see ¶ [0134], 'a static search criteria' setting screen is sent with the session ID to the requesting party...request is checked whether it is authorized or not by referring the session ID data file and simultaneously the static search criteria are registered in a static search criteria part in the user data file, [0143], 'selecting or retrieving' specific information source and distributing conditions basic data satisfying the 'search criteria' in the information source and distributing conditions basic data file. The information source and distributing conditions basic data file is data that associates each information source with its 'residing location on the network' and distributing conditions, [0136], the user selects any other service in such menu via an 'inputting' means, a process for the other service is executed).

With respect to applicant's arguments that "*Roth also fails to teach or suggest...presently amended independent claim 9*". Examiner disagrees. Ueda teaches amended claim recites limitation, therefore the argument is moot.

Examiner examines the claims based on ‘broad and reasonable interpretation of claim’ as recommended by MPEP§ 2105. *While it is appropriate to use the specification to determine what applicant intend a term to mean, a positive limitation from the specification cannot be read into a claim that does not itself impose that limitation. A broad interpretation of a claim by USPTO personnel will reduce the possibility that the claim, when issued, will be interpreted more broadly than is justified or intended. An applicant can always amend a claim during prosecution to better reflect the intended scope of the claim.*

Objection

3. Claims 9-23 are objected to for not being tied to a particular machine or apparatus.

In claim 9, the limitation of “A method” should read as “A computer implemented method”.

Claim Rejections - 35 USC § 112 2nd Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites the limitation of ‘specific format’. The term ‘specific format’ is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree and one of the ordinary skill in the art would not be reasonably appraised of the scope of

the invention. For the purposes of this examination, the term ‘specific format’ will be interpreted as any format, arrangement or system.

Claim Rejections- 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 9-12, 16, 20, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Ueda et al. (US 2002/0184200 A1), hereinafter Ueda.

With reference to claim 9, Ueda teaches **a method for exchanging newly added information over the Internet, comprising:** (see ¶ [0132], exchange mobile communication terminal network, the Internet or an intranet, the content server, an application server, and a client computer), **uploading new data from information providers or administrators into an information exchange** (see ¶ [0143], uploading the information source and distributing conditions basic data to the information source and distributing conditions basic data file of the intermediation computer system, and selecting or retrieving specific information source and distributing conditions basic data satisfying the search criteria in the information source and distributing conditions basic data file), **entering and storing search queries as static queries in a system database, which are used for retrieving information pertaining to the static queries from the internet, said static queries being input from users or subscribers to the information exchange** (see ¶ [0134], a user authentication request, or a static search criteria

Art Unit: 2164

(unchanging search criteria) registration request, [0143], [0136]), **monitoring data at the information exchange to determine whether new uploaded data has been added to the information exchange by the information providers or the administrators** (see ¶ [0267], terminal network and the internet so that it can monitor to perform operation), **determining whether any new uploaded data is responsive to the static queries** (see ¶ [0140], the session ID is authenticated and the static search criteria configured by the user is registered in the static search criteria part in the user data file, [0138]), **and if new uploaded data is determined to match the static queries sending, over the internet, the matching data to the users or subscribers who entered the static queries** (see ¶ [0134], if matched, the user is authenticated and then a session ID is registered in the session ID data file and a static search criteria setting screen is sent with the session ID to the requesting party. The request is checked whether it is authorized or not by referring the session ID data file and simultaneously the static search criteria are registered in a static search criteria part in the user data file).

With reference to claim 10, Ueda teaches **wherein the information exchange receives queries via brokers or aggregators or search engines in data feeds** (see ¶ [0162], a verification engine part that is a program to verify the behavior of the mobile communication terminal against the distribution conditions of the information source and distribution condition list is separated as an independent program).

With reference to claim 11, Ueda teaches **wherein the queries are generated by an operating system or a specific application while a user operates a wireless device or a computer or each time a search is performed using a browser or the Internet** (see ¶ [0155],

a cellular phone type mobile communication terminal, a ringer tone or a vibration may be generated to notify the reception).

With reference to claim 12, Ueda teaches **determining whether a user wishes to be notified about new results related to the queries** (see figure 9, notify requesting party), **and combining the queries with other information provided by at least one of a device, computer, web service and search engine used if the user wished to receive new results related to the queries** (see ¶ [0243], in the case of a category such as a train timetable, when the mobile communication terminal approaches a station, the time for departure of the several trains after the present time that are bound for the destination may be presented in combination with a reception notification signal, [0247]).

With reference to claim 16, Ueda teaches **continuing to monitor the uploaded data at the information exchange to determine whether new data has been added to the information exchange by the information providers or the administrators** (see ¶ [0291], monitor statistics such as an access frequency by location of mobile communication terminals or an access frequency to each of the contents in order to make use of the statistics for enriching or renovating the contents).

With reference to claim 20, Ueda teaches **charging subscribers and third parties a fee at the information exchange for distributing information** (see ¶ [0065], charge may be billed from the content providers who expect a profit by providing mobile communication terminals in a distribution area with contents).

With reference to claim 22, Ueda teaches **wherein the matching data is sent to the user or subscriber who entered the static queries over the over the Internet in a specific format**

and to a specific device (see ¶ [0143], selecting or retrieving specific information source and distributing conditions basic data satisfying the search criteria in the information source and distributing conditions basic data file, [0153]).

With reference to claim 23, Ueda teaches **wherein the specific device is at least one of a computer, a cell phone and a PDA** (see ¶ [0014, a PDA or a note PC).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13, 14, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda (US 2002/0184200 A1) and further in view of Roth et al. (US 2002/0029186 A1), hereinafter Roth.

Ueda disclose the claimed invention as detailed above in the previous paragraph. Ueda does not teach all of the limitations of claims 13, 14, 19 and 21.

With reference to claim 13, Ueda teaches claimed invention except for the limitation of advertisement. Roth teaches **wherein the other information comprises advertisements stored an ad database** (see ¶ [0007], e.g. advertisements). Also, see Ueda (page 20, claim 3). Ueda teaches a method on a network intermediates the location-based information provided by a content server (abstract), while Roth teaches a system for providing advertisements from a central server to viewers who access web sites (abstract). One of ordinary skill in the art at the

Art Unit: 2164

time of the invention would have been motivated to include the features as taught by Roth to improve network intermediates the location-based information provided by a content server of Ueda for providing advertisements from a central server to viewers who access web sites.

Therefore it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have modified the teaching of Ueda by applying the teaching of Roth to evaluate, in real time, bids submitted by different advertisers in order to determine which particular advertisement will be displayed to a viewer (see Roth [0007]).

With reference to claim 14, Ueda teaches claimed invention except for the limitation of pace bids. Roth teaches **wherein advertisers use a website and the system database to place bids and contract with the information exchange to deliver specific ads and information to targeted users or subscribers** (see ¶ [0007], e.g. bids submitted by different advertisers).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have modified the teaching of Ueda by applying the teaching of Roth to evaluate, in real time, bids submitted by different advertisers in order to determine which particular advertisement will be displayed to a viewer.

With reference to claim 19, Ueda teaches claimed invention except for the limitation of advertising. Roth teaches **attaching advertising or promotional information provided by third parties to the matching information based on subscriber queries or a topic sent to a profile of the subscribers** (see ¶ [0007]). Also, see Ueda (see ¶ [0034], attaching search conditions for the location-based information provided on a network, receiving and presenting the location-based information by accessing the verified information source).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have modified the teaching of Ueda by applying the teaching of Roth to evaluate, in real time, bids submitted by different advertisers in order to determine which particular advertisement will be displayed to a viewer.

With reference to claim 21, Ueda teaches claimed invention except for the limitation of advertisers bid. Roth teaches **wherein the fee is based on at least one of an agreed amount, a transaction fee and a dynamic market in which advertisers bid for a right to be included first in notifications** (see ¶ [0007]). Also see Ueda (¶ [0259], the shared portion in the transmitted data may be bundled together irrespective of the used encoding method and consequently, an amount of transmitted data may be reduced and transfer time and transfer costs may also be kept low, [0267]).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have modified the teaching of Ueda by applying the teaching of Roth to evaluate, in real time, bids submitted by different advertisers in order to determine which particular advertisement will be displayed to a viewer.

7. Claims 15, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda (US 2002/0184200 A1) and further in view of Crandall et al. (US 6321228 B1), hereinafter, Crandall.

With reference to claim 15, Ueda teaches **translating the combined queries and other information into a new query based on at least one of a profile of the user and search results** (see figure 11, ¶ [0138], an authorized mobile communication terminal by comparing its user ID and password with ones in the user data file, and if authenticated, the session ID is issued

Art Unit: 2164

and registered in the session ID data file, and on the other hand, a notification of registration completion is sent to the requesting party), **and entering the new query into the system database as static queries which are accessed by the information exchange** (see ¶ [0056], the search result based upon the present search conditions when a search-target area is specified as the search conditions and a plurality of the search-target area is input successively).

Ueda does not explicitly teach the limitation of ranking. Although Ueda teaches categorization (see figure 11). However, Crandall teaches ranking (see column 2, line 10-19).

Therefore it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have modified the teaching of Ueda by applying the teaching of Crandall for a system that enables internet users to access selected records retrieved from result sets that are derived from earlier search queries. Thus, when the user submits a search query to the system, it returns selected records from the collection and rank databases, in addition to other related web sites from the internet (see Crandall, column 2, line 10-30).

With reference to claim 17, Ueda teaches **wherein said determining step includes the step of analyzing, text searching and the matching data prior to translating the match information into a web link in a message engine** (see ¶ [0135], the packet exchange mobile communication terminal network is executed to ensure connection to a wireless line or a higher protocol network).

Ueda does not explicitly teach the limitation of prioritizing. Although Ueda teaches categorization (see figure 11). However, Crandall teaches prioritizing (see column 2, line 10-19).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have modified the teaching of Ueda by applying the teaching of Crandall for a system that enables internet users to access selected records retrieved from result sets that are derived from earlier search queries. Thus, when the user submits a search query to the system, it returns selected records from the collection and rank databases, in addition to other related web sites from the internet.

With reference to claim 18, Ueda teaches **wherein said determining step includes the step of analyzing, text searching and the matching data prior to combining the matching data with statistical or relevant data and control module** (see ¶ [0135] and [0132]), Ueda does not explicitly teach prioritizing, stored in an index. Although Ueda teaches categorization (see figure 11). However, Crandall teaches prioritizing, stored in an index (see column 2, line 10-19, column 1, line 47-51).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to have modified the teaching of Ueda by applying the teaching of Crandall for a system that enables internet users to access selected records retrieved from result sets that are derived from earlier search queries. Thus, when the user submits a search query to the system, it returns selected records from the collection and rank databases, in addition to other related web sites from the internet.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Daniel A Kuddus whose telephone number is (571) 270-1722. The examiner can normally be reached on Monday to Thursday 8.00 a.m.-5.30 p.m. The examiner can also be reached on alternate Fridays from 8.00 a.m. to 4.30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or processing is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from the either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 2164

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Daniel Kuddus

Date: 12/31/08

/Charles Rones/
Supervisory Patent Examiner, Art Unit 2164